

REMARKS

Claims 1-8 and 10-11 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,650,657 (Hunsicker). Claim 9 has been rejected under 35 U.S.C. § 103 as being unpatentable over Hunsicker in view of U.S. Patent No. 4,585,904 (Mincone et al.). Applicant respectfully traverses these rejections.

Hunsicker describes a telephone monitoring system for providing the user with a hard copy printout of data on outgoing and incoming calls or a visual display of the same (*see Abstract; col. 6, lines 22-44*). However, contrary to the Examiner's assertion, Hunsicker does not teach or suggest a telephone comprising a memorization or indication device, as called for in claims 1, 10 and 11.

Applicant respectfully submits that the Examiner cannot use hindsight gleaned from the present invention to reconstruct or modify the prior art reference to render claims unpatentable, particularly when his re-construction contradicts the clear teaching of the reference. In fact, Hunsicker clearly describes that the telephone monitoring system is not part of the telephone, the telephone monitoring system is coupled to the tip and ring lines associated with a telephone subset (*see Fig. 1, Abstract and col. 6, lines 44-45*). The Examiner cannot reconstruct the prior art reference such that it contradicts the clear teaching of the reference. Hunsicker specifically describes that "As seen from FIG.1, the entire unit [the telephone monitoring system] is coupled to the T and R lines of the telephone which essentially is a very simple connection to make" (emphasis added) (col. 6, lines 44-45; *see also col. 12, lines 18-19*).

Yet, the Examiner ignores the clear teaching of the Hunsicker reference and insists that "Hunsicker teaches a telephone comprising (see figure 1): a memorization or indication device ..." (Office Action, page 2, paragraph 2). Applicant kindly requests the Examiner to specifically identify the portion of the reference that supports his view that Hunsicker teaches a telephone comprising a memorization device, as claimed in claims 1, 10 and 11. It is well established that the Examiner cannot use hindsight gleaned from the present invention to modify or reconstruct the prior art reference to render claims unpatentable.

Of course, to establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2143. However, the claimed combination cannot change the principle of the operation of the primary reference or render the reference inoperable for its intended purpose. (MPEP § 2143.01 citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) and *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)).

Additionally, the claimed invention defined by apparatus claims 1, 10 and 11 eliminates the shortcomings and disadvantages encountered with the prior art. Specifically, the claimed invention allows a telephone (and not a telephone monitoring system coupled to the telephone) to accurately memorize and indicate data relating to incoming and/or outgoing calls when several telephones are connected to a single telephone line. It is undeniable that Hunsicker is not even remotely concerned with the problem of a telephone accurately memorizing and indicating data relating to incoming and/or outgoing calls when several telephones are connected to a single telephone line. Since applicant has recognized a problem not addressed by the cited prior art and solved that problem in a manner not suggested by Hunsicker, the basis for patentability of the claims is established. See *In re Wright*, 6 U.S.P.Q. 2d, 1959, 1961-1962 (Fed. Cir. 1988). There, the CAFC relied upon previous decisions requiring a consideration of the problem facing the inventor in reversing the Examiner's rejection. "The problem solved by the invention is always relevant". *Id.* at 1962. See also, *In re Rinehart*, 189 U.S.P.Q. 143, 149 (CCPA 1967), which stated that the particular problem facing the inventor must be considered in determining obviousness.

Absent evidence that the specific problem of a telephone accurately memorizing and indicating data relating to incoming and/or outgoing calls when several telephones are connected to a single telephone line was even recognized by the prior art, there can be no finding that the invention as a whole would have been obvious. As stated by the PTO Board of Appeals in Ex parte Breidt and Lefevre, 161 U.S.P.Q. 767, 768 (1968), “an inventive contribution can reside as well in the recognition of a problem as in a solution”. It further appears that the conclusion reached by the Board of Appeals in Ex parte Minks, 169 U.S.P.Q. 120 (1969), is here in point. There, the Board concluded that “[a]ppellant having discovered the source of the problem and solved the same . . . he is . . . entitled to patent protection”. Id. at 121.

Moreover, the Examiner incorrectly alleges that “it would have been obvious that more than one telephone set can be connected to the telephone line Tip and Ring. Therefore, as long as either one of the telephone set is off-hook, the monitoring device continuously counts the total minutes of the call until the called hand up the handset, e.g., called party pick up the telephone set in the kitchen and later pick up another telephone set in the living room” (Office Action, pages 2-3, paragraph 2) As indicated herein, three basic criteria must be met to establish a *prima facie* case of obviousness. Applicant respectfully submits that the Examiner has failed to establish the first criteria. There is no teaching or suggestion in the Hunsicker reference of addressing the specific problem of a telephone accurately memorizing and indicating data relating to incoming and/or outgoing calls when several telephones are connected to a single telephone. In fact, all the figures and descriptions in Hunsicker deals with one telephone monitor coupled to a single telephone. It is well established that the Examiner cannot use hindsight gleaned from the present invention to modify or reconstruct the prior art reference to render claims unpatentable.

Further, even assuming *arguendo* that the Examiner’s hindsight reconstruction of Hunsicker is proper, the Examiner’s reconstruction only works if the monitoring device is connected between a telephone central office and all the telephone sets since the off-hook detector 12 detects a current flow or a connection (that is, all the telephones must be connected downstream from the monitoring system). In other words, the Examiner’s

suggested reconstruction does not work if any secondary telephone is connected upstream from the monitoring system. It is appreciated that this is precisely the problem identified and addressed by the present invention (*see* page 1, lines 25 to page 2, line 14 of the specification). Moreover, the Examiner's reconstruction of connecting all of the telephones to the monitoring device would clearly contradict the requirements of claims 1, 10 and 11, since the present invention requires that the monitoring device to be implemented in a telephone (i.e., connected to a single telephone). Also, applicant respectfully submits that there is no suggestion or motivation in Hunsicker for such reconstruction as suggested by the Examiner. Accordingly, applicant kindly requests the Examiner to specifically identify the portion of the reference that suggest or motivates one of ordinary skilled in the art to reconstruct Hunsicker in a manner suggested by the Examiner.

Furthermore, as admitted by the Examiner, Hunsicker fails to teach or suggest a processor having a memory and a device for receiving programming signals, as required in claim 9. To cure this deficiency, the Examiner turns to Mincone et al. Mincone et al. relates to a programmable telephone call cost metering device and is not suggestive of a telephone . But, Mincone et al. is not suggestive of a telephone accurately memorizing and indicating data relating to incoming and/or outgoing calls when several telephones are connected to a single telephone line. These, of course, are features recited by independent claim 1 (and thus included in dependent claim 9) and not found in Hunsicker. Hence, the addition of Mincone et al. does not cure the aforesaid deficiency of Hunsicker. Additionally, the Examiner has failed to establish a *prima facie* case of obviousness because 1) the combination of Hunsicker and Mincone et al. does not teach or suggest all of the claim limitations; and 2) there is no motivation in Hunsicker and Mincone et al. that the teaching of these two references should be combined.

In summary, the Examiner has failed to establish a *prima facie* case of obviousness because 1) Hunsicker does not teach or suggest implementing the monitoring device directly in the telephone as required in independent claims 1, 10 and 11; 2) there is no motivation or suggestion in Hunsicker to support the Examiner's hindsight reconstruction of Hunsicker; and 3) there is no motivation in Hunsicker and Mincone et al. that the teaching of these two

references should be combined. Accordingly, applicant respectfully requests that rejection of claims 1-11 under 35 U.S.C. §103(a) be withdrawn.

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A check for \$120.00 is enclosed to cover the Petition for Extension of Time, however, should the check be missing or is insufficient, the Commissioner is hereby authorized to charge any payment or credit any overpayment to our Deposit Account No. 50-0624, under Order No. GRYN 204 (10109100) from which the undersigned is authorized to draw.

Respectfully submitted,

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